REMARKS

Rejection of Claims 1-5, 7, 8, 13, 38-42, 46, and 50-57 Under 35 U.S.C. 102(e) (Reiter)

Claim 1

Independent claim 1 is not anticipated by, and patentably distinguishes over, Reiter (U.S. Patent No. 5,819,241, hereinafter "Reiter") because Reiter fails to disclose or suggest a method for automatically preparing a client communication pertaining to a financial product for a client, wherein the client communication is for combined use with a corresponding and respective host vehicle, and wherein the method includes the steps of using decision information to automatically select variable information other than a client identification, and automatically inserting the variable information into the client communication, as recited in claim 1.

Reiter discloses a computerized mail handling system for handling mail and for placing advertisements or messages on the mail which are targeted to the intended recipient. The Office Action at page 2, paragraph 3, characterizes various portions of Reiter and suggests correlation of those portions with the steps and limitations of the present invention as set forth in claim 1. Applicant has reviewed those portions of Reiter, albeit while viewing Reiter as a whole for what it teaches as the law requires, and concludes that Reiter in fact does not disclose the invention of claim 1.

In Reiter, the mail for which the system as disclosed is designed to handle consists of letters or parcels that are sealed and ready for postage (see, e.g., column 2, lines 8-11; and column 4, lines 25-32). The Reiter system performs standard mail handling functions such as sorting and optionally weighing the mail and calculating

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and applying postage (see, e.g., column 4, lines 27-35; column 6, lines 7-11; and column 5, lines 27-28). The Reiter system as disclosed also reads the address of the intended recipient for each mail item and applies a bar code or other machine-readable identification (see, e.g., column 4, lines 33-45). The Reiter system compares the recipient identification information with a demographic database (see, e.g., column 4, lines 62-65) and, if a match is found, the system applies an advertisement or message directly to the exterior of the mail (see, e.g., column 2, lines 9-10 and 18-19; column 5, lines 1-4 and 9-11) targeted to the demographic or other such profile of the addressee (see, e.g., column 2, lines 14-22 and 41-48; and column 5, lines 8-12).

The Office Action at page 2, paragraph 3, specifically identifies column 7, lines 33-44, lines 6-10 and column 8, lines 54-64 of Reiter as identifying recited elements of the invention as set forth in claim 1. These lines of Reiter simply describe the different types of data, such as address (column 8, lines 54-64) and demographic data (column 7, lines 6-10 and 40-42) stored in the database of the Reiter system. These lines continue on to elaborate how this data can be used to match advertisers with recipients, and how this information can be used to solicit business from advertisers to promote the Reiter system (column 7, lines 33-44). Nowhere in these lines or in the balance of Reiter can Applicant find any teaching of preparing a client communication for use with the corresponding respective host vehicle wherein decision information is used to automatically select variable information which is not the client identification and automatically inserting the variable information into the client communication, as recited in claim 1.

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The Office Action at page 2, paragraph 3, cites to Fig. 1, step 13 and Fig. 3, step 47 of Reiter as teaching a method in which variable information is automatically inserted into the client communication. Applicant has reviewed the referenced figures as well as the balance of Reiter, and nowhere in Reiter can Applicant find any teaching of automatically inserting variable information into the client communication as recited in claim 1. Figure 1, step 13 and Figure 3, step 47 simply depict the step in the Reiter system wherein the advertisement is printed or applied to the exterior of the mail envelope, parcel, or package. The advertisements or messages disclosed in Reiter are simple text or graphics messages which may be selected for printing on the mail based on demographic or other such data about the recipient. Reiter does not disclose customizing the message to the individual by inserting variable information into the message. In fact, Reiter teaches away from Applicant's invention as recited in claim 1. Reiter teaches scanning mail envelopes or packages to identify the recipient and then, based on the demographic or other such profile of the recipient, Reiter teaches printing one of a group of fixed messages or advertisements on the exterior of the mail envelope, parcel, or package based on the profile of the recipient. Reiter therefore provides no suggestion or motivation for one of ordinary skill in the art to modify the teachings of Reiter to obtain a method for automatically preparing a client communication which includes the use of decision information and variable information as recited in claim 1.

Based on the aforementioned arguments, Reiter does not anticipate the invention as recited in claim 1, and that invention patentably distinguishes over the

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teachings of Reiter.

Dependent Claims 2, 38, and 39

Claims 2, 38, and 39 are not anticipated by, and patentably distinguish over, Reiter in that they depend from and more specifically recite the invention as set forth in claim 1. The deficiencies of Reiter with respect to claims 2, 38, and 39 are similar to those set forth in claim 1. The Office Action cites additional references for these rejections, which will now be addressed..

With respect to claim 2, the Office Action at page 2 cites Reiter column 7, lines 6-10 as an example of Reiter teaching variable information comprising client information. As explained previously, these lines simply describe different types of data, such as demographic data, stored in the database of the Reiter system. They do not describe variable information for insertion into client communications as recited in claims 1 and 2.

With respect to claim 38, page 3 of the Office Action cites Reiter column 15, line 66 through column 16, line 2 as an example of Reiter teaching variable information comprising text. These lines simply describe different formats for, or types of, advertisements, such as different colors, text, graphics, etc. which could be used in the Reiter system. They do not describe variable information for insertion into client communications as recited in claims 1 and 38.

With respect to claim 39, page 3 of the Office Action cites Reiter Fig. 1, step 13 as an example of Reiter teaching combining a client communication with a host vehicle to create a combined communication comprising a single document. Figure 1,

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step 13 simply depicts the step of printing or applying an advertisement or message to the exterior of a mail envelope, parcel, or package. This step does not depict combining a client communication, such as a personalized solicitation regarding a financial product, with a host vehicle, such as an account statement, to create a combined communication comprising a single document as recited in claims 1 and 39.

Dependent Claims 3-5, 7, 8, and 13

Claims 3-5, 7, 8, and 13 are not anticipated by, and patentably distinguish over, Reiter in that they depend from, and more specifically recite the invention as set forth in claims 1 and 2. The deficiencies of Reiter with respect to claims 3-5, 7, 8, and 13 are similar to those set forth for claims 1 and 2. The Office Action cites additional references for these rejections, which will now be addressed.

With respect to claims 3 and 4, page 2 of the Office Action cites Reiter column 7, lines 6-10 as an example of Reiter teaching variable information comprising client information other than a client name or a client address. As described previously, these lines simply describe different types of data, such as demographic data, stored in the database of the Reiter system. They do not describe variable information for insertion into client communications as recited in claims 1-4.

With respect to claim 5, page 3 of the Office Action cites Reiter column 13, lines 46-47 as an example of Reiter teaching variable information comprising client family information. These lines simply describe different types of targeting information, such as families, businesses, geographic areas, or zip codes, which an advertiser may use to target individuals for generalized or common advertisements with the Reiter system,

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but not individualized communications or solicitations as is taught by the present invention. Reiter does not describe variable information for insertion into client communications as recited in claims 1, 2, and 5.

With respect to claim 7, page 3 of the Office Action cites Reiter column 12, lines 24-26 and column 13, lines 46-47 as an example of Reiter teaching variable information comprising client geographic information other than client address. These lines simply describe different types of targeting information, such as families businesses, geographic areas, specific gender, specific street, etc., which an advertiser may use to target individuals for advertisement with the Reiter system. They do not describe variable information for insertion into client communications as recited in claims 1, 2, and 7.

With respect to claim 8, page 3 of the Office Action cites Reiter column 7, lines 11-20 as an example of Reiter teaching variable information comprising client purchasing information. These lines simply describe the different types of information which can be tracked by the Reiter system, such as who sends and receives the advertisements, if the recipient used any coupons provided with the advertisements, if a recipient purchases a product offered, etc. These lines do not describe variable information for insertion into client communications as recited in claims 1, 2, and 8.

With respect to claim 13, page 3 of the Office Action cites Reiter column 12, lines 26-28 as an example of Reiter teaching variable information comprising client occupation information. These lines simply explain that occupation information can be tracked by the Reiter system and an advertiser may use this information to target

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individuals of specific occupations for advertisement with the system. They do not describe variable information for insertion into client communications as recited in claims 1, 2, and 13.

Claim 40

Independent claim 40 is not anticipated by, and patentably distinguishes over, Reiter because Reiter fails to disclose or suggest a method for automatically preparing a plurality of client communications pertaining to a financial product for a plurality of clients, where the client communications are for combined use with a corresponding and respective plurality of host vehicles. The method includes the steps of using decision information to automatically select variable information other than a client identification, and automatically inserting the variable information into each of the client communications, as recited in claim 40.

The arguments presented in the patentability analysis presented for claim 1 above apply equally here. Reiter discloses a computerized mail handling system for handling mail and placing advertisements or messages on the mail which are targeted to the intended recipient of the mail. Reiter, for example, does not disclose automatically preparing a plurality of client communications for combined use with a corresponding and respective plurality of host vehicles, nor does Reiter disclose using decision information to automatically select variable information other than a client identification, and automatically inserting the variable information into each of the client communications, as recited in claim 40.

Reiter therefore does not anticipate the invention as recited in claim 40 and the invention as recited in claim 40 patentably distinguishes over the teachings of Reiter.

Dependent Claim 41

Claim 41 is not anticipated by, and patentably distinguishes over, Reiter in that it depends from and more specifically recites the invention as set forth in claim 40. The deficiencies of Reiter with respect to claim 41 are similar to those set forth in claim 40. The Office Action on page 3 additionally cites Reiter Fig. 1, step 13 as an example of Reiter teaching combining a client communication having variable information with a host vehicle to create a combined communication comprising a single document. As described previously for claim 39, Fig. 1, step 13 simply depicts the step of printing or applying the advertisement or message to the exterior of a mail envelope, parcel, or package. This step does not depict combining a client communication with a host vehicle to create a combined communication comprising a single document as recited in claims 40 and 41.

Claim 42

Independent claim 42 is not anticipated by, and patentably distinguishes over, Reiter because Reiter fails to disclose or suggest an apparatus for automatically preparing a client communication for combined use with a corresponding host vehicle, wherein the apparatus includes means for using the decision information to automatically select a subset of the variable information for the client, and output preparing means for preparing the client communication and automatically inserting the subset of variable information into the client communication, as recited in claim

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The arguments presented in the patentability analysis presented for claims 1 and 40 above apply equally here. Reiter does not anticipate the invention as recited in claim 42 and the invention as recited in claim 42 patentably distinguishes over the teachings of Reiter.

Dependent Claims 46 and 50

Claims 46 and 50 are not anticipated by, and patentably distinguish over, Reiter in that they depend from, and more specifically recite the invention as set forth in claim 42. The deficiencies of Reiter with respect to claims 46 and 50 are similar to those set forth for claim 42.

Claim 51

Independent claim 51 is not anticipated by, and patentably distinguishes over, Reiter because Reiter fails to disclose or suggest an apparatus for automatically preparing a plurality of client communications for combined use with a corresponding and respective plurality of host vehicles, wherein the apparatus includes means for using the decision information to automatically select a subset of the variable information for each of the clients, and output preparing means for preparing the client communications and automatically inserting the subset of variable information into the client communication, as recited in claim 51.

The arguments presented in the patenability analysis presented for claims 1, 40, and 42 above apply equally here. Reiter does not anticipate the invention as recited in claim 51 and the invention as recited in claim 51 patentably distinguishes

over the teachings of Reiter.

Claim 52

Independent claim 52 is not anticipated by, and patentably distinguishes over, Reiter because Reiter fails to disclose or suggest a method for automatically preparing a client communication for combined use with a corresponding host vehicle. The method includes the steps of providing a format for the client communication wherein the communication format includes a variable portion, inputting into a storage medium variable information other than a client identification and decision information, and using the decision information to select a subset of the variable information for inclusion in a variable portion of the client communication corresponding to the variable portion of the client communication format, as recited in claim 52.

The arguments presented in the patentability analysis presented for claims 1, 40, 42 and 51 above apply equally here. Page 4 of the Office Action further cites Reiter column 7, lines 53-66 as an example of Reiter teaching of providing a format for the client communication wherein the communication format includes a variable portion. These lines of Reiter simply explain that the Reiter system identifies which advertisement is to be printed on a letter or parcel to a specific receiver before the letter or parcel continues on for delivery. These lines do not teach providing a format for the client communication wherein the communication format includes a variable portion, as recited in claim 52.

Dependent Claims 53 and 54

Claims 53 and 54 are not anticipated by, and patentably distinguish over, Reiter in that they depend from, and more specifically recite the invention as set forth in claim 52. The deficiencies of Reiter with respect to claims 53 and 54 are similar to those set forth for claim 52.

Claim 55

Independent claim 55 is not anticipated by, and patentably distinguishes over, Reiter because Reiter fails to disclose or suggest a method for automatically preparing a plurality of client communications for combined use with a corresponding and respective host vehicle. The method includes the steps of providing a format for the client communications including a variable portion, inputting into a storage medium variable information other than a client identification and decision information, and using the decision information to select a subset of the variable information for inclusion in a variable portion of the client communication for that client, where the variable portion of the client communications corresponds to the variable portion of the client communication format, as recited in claim 55.

The arguments presented in the patentability analysis presented for claims 1, 40, 42, 51, and 52 above apply equally here. Reiter does not anticipate the invention as recited in claim 55 and the invention as recited in claim 55 patentably distinguishes over the teachings of Reiter.

Dependent Claims 56 and 57

Claims 56 and 57 are not anticipated by, and patentably distinguish over,

Reiter in that they depend from, and more specifically recite the invention as set forth in claim 55. The deficiencies of Reiter with respect to claims 56 and 57 are similar to those set forth for claim 55.

Rejection of Claims 6, 9-12, 14-37, and 43-49 under 35
U.S.C. 103(a) Based on Reiter and Applicant's Admitted Prior Art

Dependent Claims 6, 9-12, 14 and 16

Claims 6, 9-12, 14 and 16 patentably distinguish over Reiter in that they depend from, and more specifically recite the invention as set forth in claims 1 and 2, the patentability of which has been addressed above. The deficiencies of Reiter with respect to claims 6, 9-12, 14 and 16 are similar to that set forth for claims 1 and 2. Page 4 of the Office Action cites Reiter column 7, lines 24-39 with respect to claim 6 as an example of where Reiter allegedly teaches different variable client information. These lines simply describe the different types of data about the recipients of letters and parcels delivered by the Reiter system which may be tracked by the system, such as receiver likes and preferences (column 7, lines 24-32). These lines continue on to elaborate how this data can be used to match advertisers with recipients and how this information can be used to solicit business from advertisers to promote the Reiter system (column 7, lines 33-44). These lines of Reiter do not teach of different variable client information as recited in claim 6. Reiter thus fails to render obvious the invention as recited. Reiter provides no suggestion or motivation to make the substantial modifications and extensions required to obtain the invention.

Dependent Claims 15, 17, 31 and 33

Claims 15, 17, 31 and 33 are not anticipated by, and patentably distinguish over, Reiter in that they depend from, and more specifically recite the invention as set forth in claim 1. The deficiencies of Reiter with respect to claims 15, 17, 31 and 33 are similar to those set forth for claim 1.
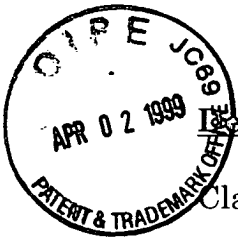
Dependent Claims 18-30

Claims 18-30 are not anticipated by, and patentably distinguish over, Reiter in that they depend from and more specifically recite the invention as set forth in claims 1 and 17. The deficiencies of Reiter with respect to claims 18-30 are similar to those set forth for claims 1 and 17, and the arguments set forth above therefore apply here as well..

Dependent Claim 32

Claim 32 is not anticipated by, and patentably distinguishes over, Reiter in that it depends from, and more specifically recites the invention as set forth in claims 1 and 31. The deficiencies of Reiter with respect to claim 32 are similar to those set forth for claims 1 and 31.

Dependent Claims 34-37

Claims 34-37 are not anticipated by, and patentably distinguish over, Reiter in that they depend from, and more specifically recite the invention as set forth in claims 1 and 33. The deficiencies of Reiter with respect to claims 34-37 are similar to those set forth for claims 1 and 33.

Dependent Claims 43-49

Claims 43-49 are not anticipated by, and patentably distinguish over, Reiter in that they depend from, and more specifically recite the invention as set forth in claim 42. The deficiencies of Reiter with respect to claims 43-49 are similar to those set forth for claim 42.

Conclusion

Applicant acknowledges the Notice of Draftsperson's Patent Drawing Review. Applicant will make the requested corrections, but wishes to defer submitting formal drawings with these corrections until payment of the issue fee.

In conclusion, Applicant respectfully submits that claims 1-56 as presented are not anticipated by and patentably distinguish over the cited and applied references, and that these claims are in condition for allowance. Reconsideration of the application is requested in view of the remarks set forth above.

A Petition for a three-month extension of time and fee are being filed concurrently with this Amendment. If any additional fees or amounts are due in connection with the filing of this paper or the prosecution of this application, please notify the undersigned so the fee can be promptly submitted.

Dated: April 2, 1999   Respectfully submitted,

Stephen T. Sullivan
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Date of Deposit April 2, 1999
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Lisa Mansur